

REMARKS

Claims 1-61 are pending in the present application. By this Response, claim 54 is amended. Claim is amended to correct minor informalities. Reconsideration of the claims in view of the above amendments and the following remarks is respectfully requested.

I. 35 U.S.C. § 102, Alleged Anticipation, Claims 1-10, 12-32 and 34-61

The Final Office Action rejects claims 1-10, 12-32 and 34-61 under 35 U.S.C. § 102(b) as being allegedly anticipated by May et al. (U.S. Patent No. 5,809,251). Because this rejection is essentially the same as in the previous Office Action, this rejection is respectfully traversed for the same reasons stated in the previous response filed June 21, 2004, the remarks of which are hereby incorporated by reference. The following remarks are provided in rebuttal to the Examiner's statements in the Final Office Action beginning on page 11, section 6, which reads as follows:

May does teach the limitations above, as addressed in the rejection of amended claim 1, above.

Applicants respectfully submit that claim 1 was previously rejected as the "method version of the claimed system discussed in claim 29" and the arguments filed were with respect to independent claim 29. Presently the Final Office Action with respect to claim 1 states:

As per claim 1, May discloses a method for automatically downloading and installing software to a computer system, (col. 2:8-10, remote installation of ... software is forwarded by a management information system into a remote computer"), comprising the steps of:

- receiving an instruction from a client computer to install an item of software on the computer system (col. 1:9-13, "Management information systems (MIS) are used to manage computing devices by monitoring and checking inventory, taking the current status of machine configurations (i.e. a machine in the status needing new software has its status sent to the MIS and the MIS is instructed to install the item of software"),

- collecting data about the computer system to form collected data (col. 1:9-13, "Management information systems (MIS) are used to

manage computing devices by monitoring and checking inventory, taking the current status of machine configurations),

- based on the collected data, determining whether the item of software can be installed on and executed by the computer system (col. 1:9-13, "Management information systems (MIS) are used to manage computing devices by monitoring and checking inventory, taking the current status of machine configurations, such as current memory configurations, hard drive capacity, RAM, CPU", and this data is used to determine whether the resources on the computer are sufficient to run the update (i.e. new item of software)),

- if the item of software can be installed on and executed by the computer system, based on the collected data, downloading a proper version of the item of software from a server and installing the proper version (col. 8:8-10, "the MIS system begins to download the (proper version of the) new files to the remote computer (to be installed)"),

- based on the collected data, setting configuration options associated with the proper version (col. 1:61-63, "Based on this information, MIS managers can schedule upgrades for outdated ... software configurations").

Final Office Action dated October 4, 2004, pages 2-3.

Claim 1, which is representative of the other rejected independent claims 15, 34 and 48 with regard to similarly recited subject matter, reads as follows:

1. A method for automatically downloading and installing software to a computer system, comprising the steps of:
 - receiving an instruction from a client computer to install an item of software on the computer system;
 - collecting data about the computer system to form collected data;
 - based on the collected data, determining whether the item of software can be installed on and executed by the computer system;
 - if the item of software can be installed on and executed by the computer system, based on the collected data, downloading a proper version of the item of software from a server;
 - installing the proper version; and
 - based on the collected data, setting configuration options associated with the proper version.

A prior art reference anticipates the claimed invention under 35 U.S.C. § 102 only if every element of a claimed invention is identically shown in that single reference, arranged as they are in the claims. In re Bond, 910 F.2d 831, 832, 15 U.S.P.Q.2d 1566, 1567 (Fed. Cir. 1990). All limitations of the claimed invention must be considered when determining patentability. In re Lowry, 32 F.3d 1579, 1582, 32 U.S.P.Q.2d 1031, 1034

(Fed. Cir. 1994). Anticipation focuses on whether a claim reads on the product or process a prior art reference discloses, not on what the reference broadly teaches. *Kalman v. Kimberly-Clark Corp.*, 713 F.2d 760, 218 U.S.P.Q. 781 (Fed. Cir. 1983). Applicants respectfully submit that May does not identically show each and every feature of the claims arranged as they are in the claims. Specifically, May does not teach receiving an instruction from a client computer to install an item of software on the computer system.

May is directed to remote installation of an update of software that is forwarded by a management information system into a remote computer. The management information system requests from the remote computer the current version information about the software within the remote computer. When the management information system determines the current version of the software within the remote computer needs to be updated, the update of the software is downloaded from the management information system to the remote computer.

Thus, in the system of May, the management information system requests the current version information about the software already installed within the remote computer and only updates, of already installed software, are remotely installed by the management information system. Nowhere, in any section of May, is it taught that an instruction is received from a client computer to install an item of software on the computer system. The Office Action alleges that this feature is taught at column 1, lines 9-13, which reads as follows:

Management information systems (MIS) are used to manage computing devices by monitoring and checking inventory, taking the current status of machine configurations (such as current memory configurations, hard drive capacity, RAM, CPU and other upgrades) as well as to monitor usage patterns.

In this section, May describes a management information system (element 11, Figure 1) that is connected through a network to computing device (element 16, Figure 1). The MIS manages the inventory of the computing device and if one of the inventory items on the computing device needs updating, the MIS schedules the upgrade of the outdated software. The MIS utilizes a desktop management interface (DMI), which is located on the computing device, to collect information about the elements on the remote computer

at the request of the MIS. May clearly teaches the management information system requests, from the DMI on the remote computer, the current version information about the software within the remote computer (see column 2, lines 14-17). In response to the request from the MIS, the DMI collects information about the elements on the remote computer and sends it to the management information system. In response to the collected information, the management information system determines the version of the software on the remote computer and if the version needs to be updated the management information system downloads the software update, as described in column 2, lines 7-10.

The Office Action dated March 25, 2004, stated that May taught the client requesting the installation of the software at column 1, lines 34-35, which reads as follows:

Within the DMI, a service layer is a program, running on the local machine or personal computer, that collects information from elements, manages that information in the MIF database, and passes the information to management applications as requested.

(Column 1, lines 31-35)

In this section, May describes that the Desktop Management Interface (DMI), which is the local agent of the MIS, collects information about the elements on the remote computer at the request of the management information system this information is sent tot the MIS. Thus, May teaches a management information system that requests version information from the remote computer and updates the version of already existing software. In contradistinction, the presently claimed invention states the client computer submit a request to the server to install an item of software on the client computer system. Thus, since the present independent claims are rejected under 35 U.S.C. § 102 which requires the prior art reference to anticipate every element of a claimed invention as identically shown in that single reference, arranged as they are in the claims, Applicants respectfully submit that May does not teach a client computer submit a request to the server to install an item of software on the client computer system

Independent claims 7, 21, 29, 40 and 54 recite similar features in their respective claim terminology. Claims 7, 21, 40 and 54 recite "receiving an instruction from a user input at a client computer to install an item of software on the at least one computer system." Claim 29 recites "wherein the client computer submits a request to the server."

Thus, May does not teach each and every feature of independent claims 1, 7, 15, 21, 29, 34, 40 and 54 as is required under 35 U.S.C. § 102. At least by virtue of their dependency on independent claims 1, 7, 15, 21, 29, 34, 40 and 54, respectively, the specific features of dependent claims 3-6, 8-10, 12-14, 17-20, 22-28, 30-32, 36-39, 41-47, 50-53 and 55-61 are not taught by May. Accordingly, Applicants respectfully request withdrawal of the rejection of claims 1, 3-10, 12-15, 17-32, 34, 36-48 and 50-61 under 35 U.S.C. § 102.

Furthermore, May does not teach, suggest, or give any incentive to make the needed changes to reach the presently claimed invention. Absent the Examiner pointing out some teaching or incentive to implement May so that an instruction is received from a client computer to install an item of software on the computer system, one of ordinary skill in the art would not be led to modify May to reach the present invention when the reference is examined as a whole. Absent some teaching, suggestion, or incentive to modify May in this manner, the presently claimed invention can be reached only through an improper use of hindsight using the Applicants' disclosure as a template to make the necessary changes to reach the claimed invention.

The Final Office Action fails to address the arguments presented by Applicants with respect to the dependent claims 3-6, 8-10, 12-14, 17-20, 22-28, 30-32, 36-39, 41-47, 50-53 and 55-61. Thus, Applicants respectfully submit that those arguments are still valid as presented in the Response filed June 21, 2004.

II. 35 U.S.C. § 103, Alleged Obviousness, Claims 11 and 33

The Final Office Action rejects claims 11 and 33 under 35 U.S.C. § 103(a) as being allegedly unpatentable over May et al. (U.S. Patent No. 5,809,251) in view of applicants admitted prior art (AAPA). This rejection is respectfully traversed.

The Final Office Action states:

In response to applicant's arguments that the examiner's conclusion of obviousness is based upon improper hindsight reasoning, it must be recognized that any judgment on obviousness is in a sense necessarily a reconstruction based upon hindsight reasoning. But so long as it takes into account only knowledge which was within the level of one of ordinary skill at the time the claimed invention was made, and does not

include knowledge gleaned only from the applicant's disclosure, such a reconstruction is proper. See *In re McLaughlin*, 443 F.2d 1392, 170 USPQ 209 (CCPA 1971). And the limitations, using HTML and HTTP, were well known within the level of ordinary skill in the art at the time the claimed invention was made.

In response to applicant's argument that there is no suggestion to combine the references, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, t USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992).

In this case, one would be motivated by the reasons stated above in the rejection of claims 11 and 13. Additionally, May, col. 1:6-8, "The present invention ... pertains particularly to the installation of software on a remote computing device.", and one of ordinary skill in the art at the time the claimed invention was made would have been well aware of the dominant remote networking/accessing technologies, HTML and HTTP, and would have wanted their system to be able to access the majority of remote computing systems by using these technologies.

Applicants respectfully submit that, since May does not teach all of the features of the presently claimed invention as discussed above, one of ordinary skill in the art at the time the invention was made would not have found it obvious to combine May with AAPA, as AAPA does not provide for the deficiencies of May and, thus, any alleged combination of May and AAPA would not be sufficient to reject independent claims 7 and 29 or claims 11 and 33 by virtue of their dependency. That is, AAPA does not teach where the client computer submits a request to the server. Thus, the only reason May would be combined with AAPA is through an impermissible use of hindsight with the benefit of Applicant's disclosure.

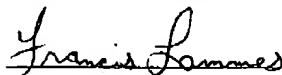
In view of the above, May and AAPA, taken either alone or in combination, fail to teach or suggest the specific features recited in independent claims 7 and 29, from which claims 11 and 33 depend. Accordingly, Applicants respectfully request withdrawal of the rejection of claims 11 and 33 under 35 U.S.C. § 103.

III. Conclusion

It is respectfully urged that the subject application is patentable over the prior art of record and is now in condition for allowance. The Examiner is invited to call the undersigned at the below-listed telephone number if in the opinion of the Examiner such a telephone conference would expedite or aid the prosecution and examination of this application.

Respectfully submitted,

DATE: December 6, 2004



Francis Lammes
Reg. No. 55,353
Yee & Associates, P.C.
P.O. Box 802333
Dallas, TX 75380
(972) 385-8777
Agent for Applicants